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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,548	10:18/2001	Yoshihito Asao	Q66775	5255

7590 06.04.2003

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EXAMINER

NGUYEN, TRAN N

ART UNIT	PAPER NUMBER
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2834

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/978,548

Applicant(s)

Examiner

Tran N. Nguyen

Art Unit

2834

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 19 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 22-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 22-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 22-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 22, last line, "a method for manufacturing the alternator wherein said insulating member is first disposed on said winding before said winding is inserted into said slots of said stator core", and Claims 23-28 contains method claimed language which does not further set the limitations of the structure of the claimed alternator, but rather the method of fabricating the alternator with assembly processing steps. In a so-called product-by-process apparatus claimed invention, the method of forming the device is not germane to the issue of patentability of the device itself (In re Thorpe, 227 USPQ 964, 966.)

Double Patenting

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper likewise extension of the "right to exclude" granted by a patent. In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); In re Van Ornum, 686 Cir. 1985); and In re Goodman, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal

disclaimer. The terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73.).

Claims 22-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of the U.S. pending patent-application 09/624222 (hereafter US_PPA'222) in view of Tamaka et al (US 4876473).

US-PPA'222 claimed an alternator substantially as the present claimed invention. While the US-PPA'222 differs from the claimed invention in only two respects that is the claimed invention's stator further comprises an insulating member being interposed between the stator core and the winding.

Tamaka, however, teaches a magnetic core (12) having insulating member made of insulation paper (4) being interposed between the core and the winding (5), wherein the insulating member is a straight base insulating member interposed between the slots and the coils (figs 3a-3b). Tamaka teaches that insulating member would prevent short-circuiting or grounding of the coil.

Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify US-PPA'222 by providing an insulating member, made of insulation paper, being interposed between the core and the winding, as taught by Tamaka. Doing so would prevent short-circuiting or grounding of the coil.

Regarding claims 29-30, the insulating member comprising either insulation paper or resin, those skilled in the art would realize that resin is widely used and well known in the art as the insulating material for providing insulation between electrical-conductive members as well as well-known as a insulating bonding material in the art. Tamaka teaches an insulating-paper used as an insulation member being interposed between the slot and winding. Therefore, it would have been obvious to an artisan to apply the Tamaka's teaching with a suitable material selection of an insulating material for the insulation member.

Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select resin as insulating material. Doing so would provide an insulating member that is well-fitted within the slot due to its elastically and adhesive characteristics. Also,

it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 41 6.

Regarding the method claimed language in claims 23-28, is not germane to the issue of patentability of the device itself (In re Thorpe, 227 USPQ 964, 966.) therefore, no patentable weight is given during the determination of patentability of the structure claimed of the alternator.

Claims 22-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of the U.S. pending-patent-application 09/734680 (hereafter, US-PPA (680) in view of Adachi (JP 09103052A) and Tamaka et al (US 4876473).

US-PPA'680 claimed an alternator substantially as the present claimed invention. The US-PPA'680 differs from the claimed invention in only three respects:

- (a) the abutting portion making the stator core into an annular shape by abutting end portions of the stator core; and,
- (b) the insulating member interposed between the core and the winding;
- (c) the insulating member is a resin material.

Regarding subsection (a), Adachi, however, teaches an alternator having a stator core with an abutting portion (51b) extending axially for forming the stator core into an annular shape (fig 1-3). Adachi teaches that this configuration of the stator core would facilitate the winding and prevent damage to the conductors of the winding. Furthermore, the Examiner takes Official Notice that magnetic core comprises with axially elongated segments) that circumferentially being combined into an annular magnetic core is well known in the art. See cited references for support of this statement.

Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the alternator by configuring the stator core with an abutting portion extending axially for forming the stator core into an annular shape, as taught by Adachi. Doing so would facilitate the winding and prevent damage to the conductors of the winding.

Regarding subsection (b), Tamaka, however, teaches a magnetic core (12) having insulating member made of insulation paper (4) being interposed between the core and the

winding (5), wherein the insulating member is a straight base insulating member interposed between the slots and the coils (figs 3a-3b). Tamaka teaches that insulating member would prevent short-circuiting or grounding of the coil.

Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify US-PPA680 by providing an insulating member, made of insulation paper, being interposed between the core and the winding, as taught by Tamaka. Doing so would prevent short-circuiting or grounding of the coil.

Regarding subsection (c), the insulating member comprising resin instead of insulation paper, those skilled in the art would realize that resin is widely used and well known in the art as the insulating material for providing insulation between electrical-conductive members as well as well-known as an insulating bonding material in the art. Tamaka teaches an insulating-paper used as an insulation member being interposed between the slot and winding. Therefore, it would have been obvious to an artisan to apply the Tamaka's teaching with a suitable material selection of an insulating material for the insulation member.

Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select resin as insulating material. Doing so would provide an insulating member that is well-fitted within the slot due to its elastically and adhesive characteristics. Also, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Regarding the method claimed language in claims 23-28, is not germane to the issue of patentability of the device itself (In re Thorpe, 227 USPQ 964, 966.) therefore, no patentable weight is given during the determination of patentability of the structure claimed of the alternator.

Response to Arguments

Applicant's arguments filed 3/10/03 have been fully considered but they are not persuasive because of the following:

The applicant argue with regards to the double patenting rejections set forth in the Office Action dated February 27, 2002, since the present application is a divisional application under 35

U.S.C 1.53(b) of U.S. Appln. No. 09/624,222 and was filed due to a restriction requirement therein, 35U.S.C. 121 prevents U.S. Appln. No. 09/624,222 from being used as a reference against the present application in a double patenting rejection (see 35 U.S.C. j 121 MPEP 804.01).

This allegation is improper interpretation of the 35 U.S.C 121. The restriction requirement restricts two groups of invention, group (I) the device's structure claims and group (II) the method claims for the device's fabricating/assembling process. In application 09/624222, the applicant elected structure claim. Thus, if the method claims for the device's fabricating/assembling process can be filed as an divisional application, based on 35USC 121, the application 09/624222 cannot be used as a ref against the method claimed invention due to the restriction set forth.

However, this divisional application is **not** the method claims for the device's fabricating/assembling process, that being restricted in 09/624222 , but based on the recitation of the independent claim, the present application **is a structure claim of the device** with additional method of forming the device, which is not germane to the issue of patentability of the device itself. (*In re Thorpe*, 227 USPQ 964, 966.). therefore, the double patenting rejection, which is relied on 09/624222, is proper.

The applicant also argues that it is well settled that a product-by-process claim, which is a product claim that defines the claimed invention in terms of the process by which it is made, is proper.

The applicant's attention is drawn to the following recitations of the claims:

In claim 22 "a method for manufacturing the alternator *wherein said insulating member is first disposed on said winding before said winding is inserted into said slots* of said stator core

In claim 23, which is the method for manufacturing the alternator, "a straight base insulating *member is first disposed* between said slots and said winding; and said insulating member is interposed between said stator core and said winding *by inserting said winding into said slots*",

In claim 24, which is the method for manufacturing the alternator, "a straight base insulating member is first disposed between said slots and said winding;"

In claims 25-28 having similar method claimed language of first disposed a component then insert other component(s).

The last two lines of claim 22 and the entire Claims 23-28 are clearly a method claimed language in a structural claimed invention according to the independent claim 22. As for the structure claimed invention, set forth in independent claim 22, the process of assembly, in this case which component is inserted or disposed first or second or even much later, would not be given any patentable weight in consideration for the patentability of the claimed structure of the device, i.e. the final product, because the final product of this present application and the claimed device in 09/624222 are similar.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tran N. Nguyen whose telephone number is (703) 308-1639. The examiner can normally be reached on M-F 7:00AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor Ramirez can be reached on (703)-308-1371. The fax phone numbers for the

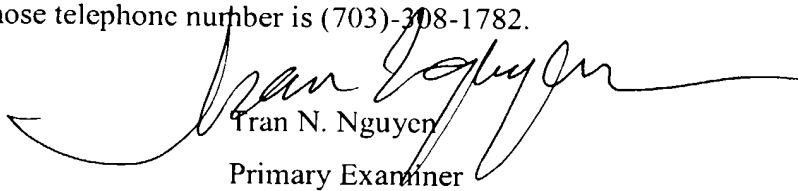
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organization where this application or proceeding is assigned are (703) 305-3431 for regular communications and (703)-305-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1782.


Tran N. Nguyen
Primary Examiner
Art Unit 2834